REMARKS

Claims 1, 5, 7, 8 and 12-24 are pending in the present application. By this Response claims 1, 5, 7, and 8 are amended and claims 15, 16, 23, and 24 are canceled. Claims 1, 5, 7, and 8 are amended to incorporate the subject matter of claims 15, 16, 23, and 24; thus, no new matter is introduced. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation, claims 1, 5, 7, 8, 12-15, and 17-23

The Office rejects claims 1, 5, 7-8, 12-15, and 17-23 under 35 U.S.C. § 102(e) as being anticipated by Salesky et al. (U.S. Patent No. 6,343,313 B1). This rejection is respectfully traversed.

As to claims 1, 5, and 7-8, the Office states:

> As per claims 1, 5, 7-8, Salesky discloses a method, client terminal, communication system, and a storage medium storing software product for communicating on a communication system having a client terminal connecting a server through a network and collaborating with other client terminals connected to said network, said method, client terminal, communication system, and a storage medium storing software product comprising the steps of:
>
> - Generating an image file in response to an operator of said client terminal specifying a screen range of said client terminal, wherein the image file is generated based on image data from the specified screen range (column 10, lines 46-67, column 11, lines 1-18);
> - Acquiring an image file name from said server (column 2, lines 5-8, 39-44, column 8, lines 35-43); Salesky teaches obtaining the captured region selected by the presenter from the server through a URL. Therefore, the image file name is specified by the URL from the server through which the image can be viewed);
> - Converting said image file to generate a predetermined formed compressed image data which has a file name relating to said image file name (column 2, lines 33-34, column 7, lines 45-50, column 11, lines 46-47, 60-67);
> - Sending said predetermined formed compressed image data to said server (column 2, lines 29-34, column 7, lines 24-27);

- Posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal (column 2, lines 39-45, column 8, lines 35-43).

Office Action dated November 2, 2005, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 5, 7, and 8 with regard to similarly recited subject matter, reads as follows:

> 1. (Previously presented) A method of communicating on a communication system having a client terminal connecting a server through a network and collaborating with other client terminals connected to said network, said method comprising the steps of:
>
> (a) generating an image file in response to an operator of said client terminal specifying a screen range of said client terminal, wherein the image file is generated based on image data from the specified screen range;
>
> (b) acquiring an image file name from said server;
>
> (c) converting said image file to generate a predetermined formed compressed image data which has a file name relating to said image file name;
>
> (d) sending said predetermined formed compressed image data to said server;
>
> (e) posting the file name of said predetermined formed compressed image data to the client terminals collaborating with said client terminal, wherein the operator of said client terminal specifies the screen range during a capture mode;
>
> (f) suspending the capture mode;
>
> (g) receiving input from the operator to activate a hidden window image; and
>
> (h) resuming the capture mode.

Claims 1, 5, 7, and 8 are amended to incorporate the subject matter of claim 15, 16, 23, and 24, and, thus, the following arguments are directed toward the combination of Salesky and Griffin as applied to the dependent claims.

The Office rejects the subject matter of claims 16 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Salesky et al. (U.S. Patent No. 6,343,313 B1) in view of Griffin et al. (U.S. Patent No. 5,307,086). This rejection is respectfully traversed.

As to the subject matter of claims 16 and 24, the Office states:

> Salesky discloses the method and storage medium of claims 15 and 23. Salesky does not explicitly discloses wherein said software product further comprising directing said client terminal to suspend the capture mode, receive input from the operator to activate a hidden window, and

> resume the capture mode. However, in analogous art, Griffin discloses a preview window normally hidden in the sense that it is displayed only temporarily in response to a specific user input, the system waits for further inputs from the user. The mouse messages are captured for the sake of stability (column 4, lines 55-67, column 5, lines 1-31).
>
> Therefore, one or ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Griffin's suspend the capture mode, receive input from the operator to activate a hidden window, and resume the capture mode in Salesky's method for the sake of stability so that the system does not jump around gathering and then displaying underlying data.

The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). In this case, the Salesky and Griffin do not teach or suggest all of the features asserted to be present by the Office. Applicant respectfully submits that Salesky and Griffin, taken alone or in combination, fail to teach or suggest suspending the capture mode, receiving input from the operator to activate a hidden window image, and resuming the capture mode.

The Office acknowledges that "Salesky does not explicitly discloses wherein said software product further comprising directing said client terminal to suspend the capture mode, receive input from the operator to activate a hidden window, and resume the capture mode." However, the Office relies on Griffin as teaching these features.

Griffin is directed to implementing a preview window in an object oriented programming system that includes an application having at least a first panel and a second panel that are selectively displayable on a display screen. The second panel displays underlying information and the first panel displays an abbreviated representation of the underlying information. The user can temporarily display a preview window that contains underlying information while viewing the first panel.

Thus, Griffin merely displays more detailed information of the abbreviated information displayed in a first screen. The Office alleges that Griffin teaches suspending the capture mode, receiving input from the operator to activate a hidden window image, and resuming the capture mode at column 4, line 55, to column 5, line 31, which reads as follows:

> Referring now to FIG. 5, there is shown a flow chart that illustrates the logic of the software implementation of the present invention. First, the system is initialized at block 61. The initialization includes loading and starting the electronic calendar application. Then a normally hidden preview window is created at block 63 and hidden at block 65. The preview window is normally hidden in the sense that it is displayed only temporarily in response to a specific user input. After the preview window has been created and hidden, the system waits for user input at block 67. When the system receives a user input, it tests at decision block 69 whether or not the user input is mouse button number two down. If the input is anything other than mouse button number two down, the system processes the input as usual, as indicated generally at block 71, and returns to block 67 to continue waiting for user input. If, on the other hand, the user input is mouse button number two down, then the system, at block 73, converts the point on the screen where the pointer was located when mouse button 2 was pressed (aPoint to aDate. In the embodiment disclosed, aDate is nil whenever aPoint is not in one of the graphical representations, such as box 35 of FIGS. 2 and 3. The system then tests, at decision block 75, whether or not aDate is nil; if it is, the preview window is or, if it is already hidden, remains hidden at block 77 and the system returns to block 67 and continues to wait for user input. If, on the other hand, aDate is not nil, the system at block 79 updates the preview window by fetching the underlying information that would appear in text entry pane 25 of the daily panel of FIG. 1. After the preview window has been updated at block 79, the system captures all future user input from the mouse other than button2up at block 81, and the system ignores them. The future mouse messages are captured for the sake of stability so that the system does not jump around gathering and then displaying other underlying data. Then, at block 83, the system unhides the preview window. After the preview window has been unhidden, the system tests at decision block 85 whether or not mouse button number two is up. As long as mouse button number two remains down (not up at decision block 85) the preview window remains unhidden. However, when mouse button number two is released, aDate is set to nil at block 87 and the capture of mouse messages is cleared at block 89. Then the system returns to decision block 75 to test whether or not aDate is nil. Since it is, the system hides the preview window at block 77, and returns to block 67 to wait for another user input.

In this section, Griffin describes a user indicating a need to see additional information regarding a specific date based upon the user pressing mouse button two. Once the user presses the mouse button two, the additional information not shown in a first screen is shown in a preview window. If during the time the mouse button two is depressed, any other mouse actions are received by the system, the system captures those mouse actions,

and the system ignores them. These mouse actions (messages) are ignored for the sake of stability. The presently claimed invention first **suspends a capture mode, receives input from the operator to activate a hidden window image**, and then **resumes the capture mode**. Thus, Griffin actually teaches away from the present invention by **initiating a capture mode** upon receiving user input where a mouse two button is depressed, **ignoring messages** captured while the mouse two button is depressed, and **ending the capture mode** when the mouse two button is released by the user. Thus, Griffin does not teach or fairly suggest the specific features as recited in claims 1, 5, 7, and 8.

Furthermore, there is not so much as a suggestion in the Salesky or Griffin references to modify the references to include such features. The mere fact that a prior art reference can be readily modified does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Laskowski*, 871 F.2d 115, 10 U.S.P.Q.2d 1397 (Fed. Cir. 1989) and also see *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) and *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1993). The Office may not merely state that the modification would have been obvious to one of ordinary skill in the art without pointing out in the prior art a suggestion of the desirability of the proposed modification.

In this case, no teaching or suggestion is present in Salesky and Griffin, either alone or in combination, to teach or suggest the needed modifications. That is, no teaching or suggestion is present in either reference that a problem exists for which suspending the capture mode, receiving input from the operator to activate a hidden window image, and resuming the capture mode, is a solution. To the contrary, Salesky teaches capturing information and displaying the information to other clients. Griffin teaches initiating a capture mode upon receiving user input where a mouse two button is depressed, ignoring messages captured while the mouse two button is depressed, and ending the capture mode when the mouse two button is released by the user. Neither reference recognizes a need to perform the features, or similar features, as recited in claims 1, 5, 7, and 8.

Moreover, neither Salesky nor Griffin teaches or suggests the desirability of incorporating the subject matter of the other when these cited references are considered

as a whole by one of ordinary skill in the art. That is, there is no motivation offered in either reference for the alleged combination. The Office alleges that the motivation for the combination is "so that the system does not jump around gathering information and then displaying underlying data." As discussed above, Griffin actually gathers information while the capture mode is initiated. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of Applicant's claimed invention thereby constituting impermissible hindsight reconstruction using Applicant's own disclosure as a guide.

One of ordinary skill in the art, being presented only with Salesky and Griffin, and without having a prior knowledge of Applicant's claimed invention, would not have found it obvious to combine and modify Salesky and Griffin to arrive at Applicant's claimed invention. To the contrary, even if one were somehow motivated to combine Salesky and Griffin, and it were somehow possible to combine the two systems, the result would not be the invention, as recited in claims 1, 5, 7, and 8. The result would be capturing information during the capture mode and then ignoring it.

Thus, Salesky and Griffin, taken alone or in combination, fail to teach or suggest all of the features in independent claims 1, 5, 7, and 8. At least by virtue of their dependency on claims 1, 5, and 8, the specific features of claims 12-14, 17-19, and 20-22 are not taught or suggested by Salesky and Griffin, either alone or in combination. Accordingly, Applicant respectively requests withdrawal of the rejection of claims 1, 5, 7, 8, 12-14, 17-19, and 20-22 35 U.S.C. § 102 or 103.

II. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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